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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,560

12/11/2003

Yukio Heki

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08/04/2006

THE PROCTER & GAMBLE COMPANY
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EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,560

Applicant(s)

HEKI ET AL.

Examiner

Igor Borissov

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 3 and 11-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

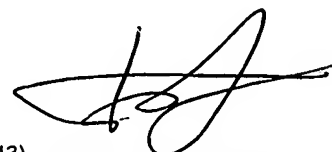
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____


IGOR N. BORISSOV
PRIMARY EXAMINER

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- A. Claims 1-10, drawn to a method for selecting a disposable absorbent article based on received information from a user, classified in class 705, subclass 2.
- B. Claims 11-16, drawn to a method for calculating a value of the quality of live based on collected data, classified in class 705, subclass 1.

Inventions A and B are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention A has utility separate from that of inventions B such as recommending a suitable for a user disposable absorbent article. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, or patentability requirements, restriction for examination purposes as indicated is proper.

Species

In the event applicant elects Invention A above, applicant is further obligated to elect among the following species as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: Claims 1, 2, 4-10.

Species 2: 3.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An arrangement that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of the generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. (MPEP 809.02(a)).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with David Weirich, Esq., Reg. No. 38,361 on July 27, 2006 a provisional election was made without traverse to prosecute the invention of A, claims 1, 2, 4-10. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 3 and 11-16 are withdrawn from further consideration by the examiner, 37 FR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, the claim is confusing, because the preamble of the claim does not correspond to the body of the claim. The preamble recites a method of recommending a disposable article, while the body of the claim does not provide any indication of such recommendation.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 4-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 2, 4-10 recite a series of steps which do not include a pre- or post-computer activity but merely perform a series of steps of receiving data and selecting an article, which can be understood as steps performed by a computer. A process is statutory if it requires physical acts to be performed outside of the computer,

independent of, and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8). The claims merely manipulate an abstract idea (receiving or generating data) without limitation to any practical application. A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335, 200 USPQ at 139).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisanaka et al. (US 2002/0096182) in view of Teagarden et al. (US 6,014,631).

Claim 1. Hisanaka et al. (Hisanaka) teaches a method of selection absorbent article based on information received about incontinence person, wherein said information is provided by a care person, and wherein said selecting of the absorbent articles such as disposable diapers and sanitary napkins is conducted to conform to the user's physiological and psychological requirements [0007]; [0011].

Hisanaka does not specifically teach that said received information includes information about incontinence devices which are currently used by the person.

Teagarden et al. (Teagarden) teaches a method of recommending a medication product to be used by a person for improving health condition of the person, wherein a new medication product is prescribed to a person based, at least in part, on information

regarding medication product currently used by the person (C. 8, L. 42-50; C. 10, L. 60-63).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hisanaka to include that said received information includes information about product currently used by the person, as disclosed in Teagarden, because it would advantageously allow to design appropriate patient care through collection of appropriate information on a patient's use of medical products, and patient's satisfaction, as indicated in Teagarden (C. 6, L. 50-53).

Claims 2 and 10. The method steps disclosed in Hisanaka and Teagarden would be performed regardless how many articles are selected, and what type of articles is selected. The motivation to modify references would be to expand line of medical product offered to customers for accommodating various medical conditions of patients.

Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisanaka et al. in view of Teagarden et al. and further in view of Snitkin (US 2003/0046111).

Claim 4. Hisanaka in view of Teagarden teach all the limitations of claim 4, except specifically teaching that said step of receiving information comprises the step of indicating a question and a plurality of possible answers for selection.

Snitkin teaches a method for treating pelvic floor disorders, wherein in order to evaluate and improve the quality of health care, a plurality of questions with a plurality of possible answers for selection for each questions are provided to obtain information regarding urinary incontinence (Fig. 3d).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hisanaka in view of Teagarden to include that said step of receiving information comprises the step of indicating a question and a plurality of possible answers for selection, as disclosed in Snitkin, because it would

advantageously allow to improve the quality of health care, as specifically stated in Snitkin [0013].

Claims 5-9, see reasoning applied to claim 4. Information as to the specific content of the questions cannot change the method steps performed as disclosed in Hisanaka in view of Teagarden and further in view of Snitkin. Therefore, said information is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*" The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

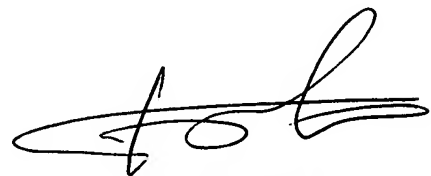
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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8/01/2006



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PRIMARY EXAMINER